

REMARKS

Claims 28, 32-41 and 43-46 are pending in the instant application. Claims 28, 32-41 and 43-46 have been rejected. Claims 28, 32-39, 41-43 and 46 have been cancelled. Claim 40 has been amended. Support for these amendments can be found in the specification. After entry of this amendment, Claims 40 and 44-45 will remain pending.

Applicants would like to thank Examiner Loewe for speaking with their representative Nicole Beeler on February 01, 2010. The Examiner's time and guidance is appreciated.

Rejection of Claims 28, 32-41 and 43-46 for Obviousness over Dorn et al. (U.S. Patent No. 5,719,147)

The Examiner has rejected Claims 28, 32-41 and 43-46 under 35 U.S.C. § 103(a) as being obvious over Dorn et al. (U.S. Patent No. 5,719,147). Specifically, the Examiner alleges that the prior art teaches the preparation of products which are within the scope of the instant claims. The Examiner further claims that the reference teaches various reactions which lead to the products of the instant invention.

The Applicants respectfully traverse this rejection. The Applicants respectfully assert that U.S. Patent No. 5,719,147 (hereinafter "the '147 patent") does not disclose nor suggest the claimed invention, nor would the '147 patent have motivated or enabled one skilled in the art to prepare the subject compound in accordance with the claimed invention. The Examiner has failed to demonstrate the specific motivation in the '147 patent that would have motivated or directed one of ordinary skill in the art to prepare the subject compound in accordance with the claimed invention. Applicants respectfully submit that the Examiner has not made a prima facie case of obviousness, such that a showing of secondary indicia of non-obviousness such as unexpected results would be required.

To establish a prima facie case of obviousness, all of the claim limitations must be taught or suggested by the prior art (see MPEP 2143.03). Applicants submit that the '147 patent does not teach all of the limitations described in the pending claims. Applicants have provided specific steps and reagents that are not taught or suggested in the prior art.

Applicants submit that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning. There is no teaching or motivation in the '147 patent to choose the specific reagents and steps described in the pending claims to make this particular compound (aprepitant). It is improper for the Examiner to pick and choose experimental procedures, change preparation steps and choose reagents when the prior art does not direct one of ordinary skill in the art to do so. Applicants respectfully submit that one of ordinary skill in the art would not have

utilized such disclosure in the '147 patent, which describes different reaction processes and synthetic manipulations, to provide the claimed invention.

Applicants request that the Examiner reconsider the arguments advanced in their response of November 16, 2009 explaining that the instant invention utilizes much less organic solvent and waste than the prior art, teaches a process that has less purification steps and gives a product in a higher yield.

Accordingly, Applicants respectfully submit that the rejection of Claims 28, 32-41 and 43-46 and under 35 U.S.C. § 103(a) as being obvious over Dorn et al. (U.S. Patent No. 5,719,147) be withdrawn.

If a telephonic communication with the Applicants' representative will advance the prosecution of the instant application, please telephone the representative indicated below. Applicants believe no additional fees are due but the Commissioner is authorized to charge any fees required in connection with this response to Merck Deposit Account No. 13-2755.

Respectfully submitted,

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